

REMARKS

Claims 5, 6, 9 and 12 remain herein. Claim 9 is amended. Claims 1-4, 7, 8, 10 and 11 are presently withdrawn from consideration.

1. Claim 9 was rejected under 35 U.S.C. § 101. Amended claim 9 now recites various physical components (e.g., frequency converter, end of block detector, quantizer, encoder) performing steps of the claimed encoding method. See Applicants' Fig. 10. Because the method steps are tied to concrete elements, reconsideration and withdrawal of the rejection under 35 U.S.C. § 101 are respectfully requested.

2. Claims 5-6 and 9 were rejected under 35 U.S.C. § 103 (a) over Honma in view of Chu.

Honma and Chu fail to teach or suggest an "EOB detector for outputting the position of the non-zero quantized frequency component in the predetermined scanning order as a control signal to the quantizer and the encoder," as recited in applicants' claim 5. The Office Action alleges the VLC encoder 408 of Chu, substituted to include the coding circuit 826a of Honma, teaches or suggests applicants' claim 5. The Office Action alleges that coding circuit 826a of Honma describes a quantizer and a VLC encoder as shown in Fig. 23 of Honma, and that supplying a non-zero quantized coefficient to the coding circuit 826a suggests applicants' claim 5.

One of ordinary skill in this art would not have combined the references in the

manner suggested in the Office Action. Col. 24, lines 15-16 of Honma describe that the end of bit signal is generated by VLC encoder 832 within coding circuit 826. However, Chu externally provides non-zero quantized coefficients to VLC encoding circuit 408. Thus, substituting VLC encoding circuit 408 of Chu with coding circuit 826 of Honma would render the end of bit signal generated by the coding circuit 826 of Honma redundant and superfluous. The combination of the two cited references “cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose.” See MPEP §§2143.01; 2145(III); 2145(X)(D). The Office Action has not articulated a rationale that would have led one of ordinary skill in the art to combine Honma and Chu, despite the resulting redundancy of EOB signals.

Thus, there is no disclosure or teaching in any of Honma ‘848, Chu ‘629 or anything else in this record that would have suggested applicants’ claimed invention to one of ordinary skill in this art. Further, there is no disclosure or teaching in any of these references, and no sound basis stated in this record, that would have suggested the desirability of combining any portions thereof effectively to anticipate or render obvious applicants’ claimed invention. Accordingly, reconsideration and withdrawal of these grounds of rejection, and allowance of claims 5,6 and 9 are respectfully requested.

3. Claim 12 was rejected under 35 U.S.C. § 103 (a) over Honma ‘848, Chu ‘629 and Kobayashi ‘408. Kobayahsi ‘408 is cited as allegedly disclosing only an image encoding method on a computer readable medium. Kobayahsi ‘408 fails to disclose what is missing in

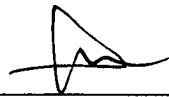
Honma '848 and Chu '629, as noted above with respect to claim 5. Thus, claim 12 is patentable over Honma '848, Chu '629 and Kobayashi '408.

Accordingly, the application is now fully in condition for allowance and a notice to that effect is respectfully requested. The PTO is hereby authorized to charge/credit any fee deficiencies or overpayments to Deposit Account No. 19-4293. If further amendments would place this application in even better condition for issue, the Examiner is invited to call applicant's undersigned attorney at the number listed below.

Respectfully submitted,

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